



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED: August 6, 1993

Paper No. 28

In re application of
George J. Murakawa et al.

Serial No. 07/402,450

For: METHOD AND AMPLIFICATION AND : Decision on Petition
DETECTION OF RNA SEQUENCES :

Applicants have filed a petition on July 20, 1993, under 37 CFR 1.181, which petition requests supervisory intervention regarding the Examiner's denial of entry and consideration of the Reply Brief filed on May 7, 1993. The Examiner issued, in an Office action dated July 9, 1993, a denial of entry of the Reply Brief on the ground that the newly supplied arguments were not directed to new issues raised by the Examiner in the Examiner's Answer and, accordingly, were untimely (37 CFR 1.193(b)).

Applicants' petition challenges the denial of entry by the Examiner on the basis that the new point of argument was the examiner's amplification of his reasoning associated with the application of the teachings of the cited references. It is noted, however, that the amplification by the examiner was in response to the applicants' amplification of their position in the Brief on Appeal and was necessitated by the examiner's obligation to address all of applicants' substantive arguments.

To follow applicant's line of reasoning, regarding the need to continue prosecution via the entry of the Reply Brief, would be tantamount to the continuation of prosecution ad nauseam. According to applicants' position, prosecution would only cease when applicant ran out of new points of argument, or amplifications thereof, which would obviate a need for the examiner to respond thereto.

Upon a thorough review of the positions of the applicants and the examiner, I find that the examiner acted properly to deny entry and consideration of the Reply Brief in question. Accordingly, the petition is denied. The application is being forwarded to the Board of Patent Appeals and Interferences for a decision on the appeal in due course.

PETITION DENIED

Barry S. Richman, Director
Patent Examining Group 1800
Biotechnology

Edward S. Irons
919 - 18th Street, N.W., Ste. 800
Washington, DC 20006

DESIGNATION OF PANEL

Appeal of S.N. _____

Interference No. _____

Pursuant to (1) the Commissioner's authority to designate the members of the Board of Patent Appeals and Interferences to hear cases before the Board (35 U.S.C. 7(b)), and (2) Commissioner Lehman's memorandum dated May 1, 1994 (delegating to the Chief Administrative Patent Judge the responsibility of designating members to hear cases before the Board), it is

ORDERED that the panel of the Board of Patent Appeals and Interferences designated to hear this case shall consist of the following members of the Board:

☒ On Brief

☐ Heard

☐ Redesignation

☐ Expanded Panel

1. Judge Smith, W.
2. Judge Gron
3. Judge Smith, John
4. Judge _____
5. Judge _____
6. Judge _____
7. Judge _____
8. Judge _____
9. Judge _____
10. Judge _____
11. Judge _____


BRUCE H. STONER
 Acting Chief Administrative Patent Judge

Date of Assignment/Hearing: 2/9/98

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